

REMARKS/ARGUMENTS

Claims 1-9, and 11-17 are presently pending. Claims 1-7 and 14-17 have been cancelled. Claim 12 has been amended. New claims 18 and 19 have been added. Accordingly, claims 8, 9, 11-13, and 18-19 will remain pending upon entry of the instant amendments. *No new matter has been added.*

Claim 12 has been amended to more particularly point out and distinctly claim the subject matter that Applicants regard as the invention, *e.g.*, reciting a more specific list of protecting groups. Support for this amendment may be found at least, for example, in the specification on page 8, line 30 to page 9, line 1.

Support for the newly added claim 18 may be found at least, for example, in the specification on page 9, line 3.

Support for the newly added claim 19 may be found at least, for example, throughout the specification and original claim 13.

Moreover, amendment and/or cancellation of the claims during pendency of the application are not to be construed as acquiescence to any of the objections/rejections set forth in any Office Action, and were done solely to expedite prosecution of the application. Applicants submit that claims were not added or amended during prosecution of the instant application for reasons related to patentability. Applicants reserve the right to pursue the claims as originally filed, subsequently amended or added, or similar claims, in this or one or more subsequent applications.

Allowable subject matter

Applicants appreciate the Examiner's acknowledgement that claim 13 is free of prior art. However, the Examiner has objected to claim 13, suggesting that it is "dependent on a rejected base claim." Solely to expedite prosecution, Applicants have amended the base claim, claim 12. Applicants assert that the amendments now made to the base claim (claim 12) should serve to overcome the objection to claim 13, without need for any amendment of claim 13.

Claim Rejections under 35 USC §112

Rejection of Claim 12 under 35 USC §112, First Paragraph

Claim 12 stands rejected under 35 USC §112, first paragraph. In particular, the Office Action suggests on page 3 that the specification “while being enabling for a compound of Formula IV where P is an isobutoxycarbonyl group, does not reasonably provide enablement for all of the other P groups listed.

Applicants respectfully disagree with the reasoning provided in the Office Action. However, solely in order to expedite prosecution, claim 12 has been limited to a specific range of protecting groups:

“wherein P is an acyl group, an aroyl group, a C₁₋₆alkoxycarbonyl group or an arylmethoxycarbonyl group.”

Support for this amendment may be found in the specification on page 8, line 30, to page 9, line 1.

Moreover, Applicants assert that the ordinarily skilled artisan could make and use the invention commensurate in scope with amended claim 12 (which has been amended to incorporate a significant limitation to expedite prosecution) without undue experimentation.

As such, Applicants respectfully request withdrawal of the rejection of claim 12 under 35 USC §112, first paragraph, and favorable reconsideration.

Rejection of Claim 12 under 35 USC §112, Second Paragraph

The Examiner has rejected claim 12 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. In particular, the Examiner has suggested that “[t]he scope of ‘P’ requires clarification.”

Applicants respectfully disagree. However, solely in order to expedite prosecution, claim 12 has been amended. In this regard, Applicants assert that the amendment to claim 12 clarifies the scope of “P” to the ordinarily skilled artisan, such that the scope of amended claim 12 would be clearly understood and sufficiently definite.

As such, Applicants respectfully request withdrawal of the rejection of claim 12 under 35 USC §112, second paragraph, and favorable reconsideration.

Request for Phone Interview

Once the Examiner has had an opportunity to review the comments made herein, Applicants respectfully request a phone interview in order to discuss any final details that may help result in an allowance of the application with all pending claims.

CONCLUSION

Applicants respectfully request favorable reconsideration of all rejections/objections. As noted above, if a telephone conversation with Applicants' attorney would help to expedite the prosecution of the above-identified application, the Examiner is urged to call Applicants' attorney at the telephone number below.

The above amendments have been made without prejudice to Applicants right to prosecute any cancelled subject matter in a timely filed continuation application.

Although no fees are believed due at this time, the Commissioner is hereby authorized to charge any deficiency in the fees or credit any overpayment to deposit account No. 50-3231, referencing Attorney Docket No. 101358-1P US.

Respectfully submitted,
/Jacob G. Weintraub/

Name: Jacob G. Weintraub
Dated: April 27, 2009
Reg. No.: 56469
Phone No.: 1 781 839 4182
Global Intellectual Property, Patents,
AstraZeneca R&D Boston,
35, Gatehouse Drive,
Waltham,
MA 02451